Claims 4, 5, and 10 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly concealing the best mode of the invention. The Examiner states that the applicant has not disclosed the manner in which the damping valve achieves a pre-controlled setting, which depends upon whether the vibration damper is in a compression state or in a rebound state. It is respectfully submitted that those skilled in the art of vibration dampers would know that the actuator may be used to actuate the valve to a pre-controlled setting position in either the rebound or the compression state instead of a variable position. Accordingly, it is respectfully submitted that the rejection of claims 4, 5, and 10 should be withdrawn.

Claims 1-10 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,035,306 (Ashiba).

Before discussing the prior art and the Examiner's rejections of the claims in view of the prior art, a brief summary of the present invention is appropriate. The present invention is directed to a vibration damper having a cylinder and a piston axially movably arranged therein. The piston divides the cylinder into first and second working spaces which are filled with a damping fluid. First and second non-return valves are arranged in the piston for respectively conducting damping fluid in the compression and rebound directions of the vibration damper. A damping valve is arranged in series with the first and second non-return valves such that damping fluid is conducted by the damping valve in both the compression and rebound directions. The damping valve is externally actuatable for varying the damping characteristics thereof. Furthermore, the damping fluid is required to flow through the damping valve and one of the first and second non-return valves whenever damping fluid is conducted from one working space of the cylinder to the other in the compression and rebound directions of the vibration damper.

Independent claim 1 recites "wherein said damping valve in series with said first and second non-return valves comprise a sole passage for said damping medium between said two working spaces such that said damping fluid is required to flow through said damping valve when damping fluid is exchanged between said two working spaces in the rebound and the compression directions of the vibration damper".

It is respectfully submitted that independent claim 1 is not anticipated by Ashiba because Ashiba fails to disclose (1) that the valve 33 and the two non-return valves 21, 22 in series therewith produce the sole passage between the two working spaces and (2) that the valve 33 in series with the two non-return valves 21, 22 has a variable damping action.

In contrast to the present invention, Ashiba discloses a vibration damper having a valve 33 in series with two non-return valves 21, 22 which define a passage 13 between two working spaces of the vibration damper. However, the passage 13 is not the sole passage between the two working spaces of the vibration damper. Ashiba further includes passages 14, 15 arranged parallel to the passage 13.

Accordingly, it is respectfully submitted that independent claim 1 is not anticipated by Ashiba because Ashiba fails to teach or suggest a damping valve in series with two non-return valves which provides the sole passage for damping fluid between two working spaces of a cylinder.

It is respectfully submitted that independent claim 1 is also not anticipated by Ashiba because Ashiba fails to disclose the recitation "a damping valve arranged in one of said piston and said piston rod having a variable damping action". The present invention requires that the damping valve itself have a variable damping action. In contrast to independent claim 1, Ashiba teaches that the valve 33 may be actuated to an opened or closed state by an actuator.

Ashiba teaches that the valve 33 and valve seat 32 are specifically designed to be maintained in either the open or closed position (see col. 9, lines 38-46). Accordingly, Ashiba regulates the damping force of the vibration damper by switching the passage 13 in which the non-return valves 21, 22 are arranged between an open and closed position. Accordingly, Ashiba fails to disclose "a damping valve arranged in one of said piston and said piston rod having a variable damping action" because the valve 33 and valve seat 32 are not designed to have a variable damping action. Rather, valve 33 and valve seat 32 are arranged to be maintained in either the open or closed positions only.

It is respectfully submitted that independent claim 1 is also allowable over Ashiba because the switching characteristic of the valve taught by Ashiba teaches away from a valve having a variable damping action.

Dependent claims 2-10, being dependent on independent claim 1, are allowable for the same reasons that independent claim 1 is allowable.

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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By _____

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Dated: April 10, 2001

VERSION WITH MARKINGS TO SHOW CHANGES

IN THE CLAIMS:

Amend claim 1 as follows:

1. A vibration damper with variable damping force, comprising:

a working cylinder filled with damping medium;

a piston fastened to a piston rod arranged in an axially movable manner in said working cylinder and dividing the working cylinder into two working spaces;

first and second non-return valves arranged in said piston for respectively providing a damping force for the rebound and compression directions of the vibration damper; and

a damping valve arranged in one of said piston and said piston rod having a variable damping action and arranged in series with each of said first and second non-return valves, thereby acting in both said rebound and compression directions of the vibration damper, wherein said damping valve in series with said first and second non-return valves comprise a sole passage for said damping medium between said two working spaces such that said damping fluid is required to flow through said damping valve when damping fluid is exchanged between said two working spaces in the rebound and the compression directions of the vibration damper.